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09/587,058 06/02/00 SCHIERLING

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EXAMINER

PM82/0507

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ART UNIT

PAPER NUMBER

3681

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/587,058

Applicant(s)
Bernhard Schierling

Examiner
Rodney H. Bonck

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3681



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 23, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

The following action is in response to the amendment received March 23, 2001, Paper No. 7.

Reissue Applications

Claims 5-8 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The record of the application for the patent shows that recitation that the insulating member comprises a metal portion and an additional portion was deemed to distinguish the claims over the prior art (see the supplemental final rejection, Paper No. 12, applicant's "REMARKS" of Paper No. 16, and the Reasons for Allowance, Paper No. 18). Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 5, 6, and 8 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Hays('704). With respect to claims 5 and 8, Hays discloses a single disc friction clutch comprising a clutch housing 12, a single clutch disc 14, a solid pressure plate 16, a friction lining 18 on the clutch disc, a membrane spring 30, and a thermal insulating member 44,56. The thermal insulating member is supported on the surface of the pressure plate between the pressure plate and the membrane spring, and is configured to minimize the contact between the thermal insulating member and the membrane spring (see column 6, lines 4-8). The thermal insulating member extends circumferentially about the pressure plate and has a first resistance to thermal conductivity. The membrane spring also inherently has a resistance to thermal conductivity. Since the thermal insulating member includes a molded plastic portion, it would have a higher resistance to thermal conductivity than that of the membrane spring. The thermal insulating member is rigid and comprises a metal, since the portion 44 is metal (column 6, lines 9-14). The

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metal of the insulating member is configured to minimize heat conduction from the pressure plate to the membrane spring (column 6, lines 4-8). With respect to claim 6, the insulating member of Hays includes a first surface contacting the membrane spring and a second surface contacting the pressure plate (see, for example, Figs. 2 and 3).

Allowable Subject Matter

Claims 1-4 are allowed.

Response to Arguments

Applicant's arguments filed January 22, 2001, in the initial response to the Office action of October 25, 2000, have been fully considered but they are not persuasive. Applicant argues that the claims are not subject to the recapture rule because they are narrower in an aspect germane to the prior art rejection although they may be broader in other respects.

Claims 1-4 of the '674 patent are essentially claims 26, 31, 33, and 40 of the application rewritten in independent form. Those claims required that the insulating member comprises a metal portion and an additional portion. It is this respect that is broadened by claims 5-8 since claims 5-8 do not require the additional portion. Thus the broadening aspect of claims 5-8 is clearly germane to the prior art rejection and would constitute improper recapture.

Applicant argues that recitation that the insulating member is only in axial contact with the radially extending surface of the membrane spring and that the insulating member extends

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circumferentially about the pressure plate are narrowing aspects and are germane to the prior art rejection. It is not clear why these features would be germane to the prior art rejection since several of the prior art references appear to show these features. Note, for example, the Hays ('704) reference where insulating member 44 is in axial contact with a radially extending portion of membrane spring 30 and the insulating member extends circumferentially (there is a circumferential arrangement of a series of balls and the retainer ring extends circumferentially).

Applicant maintains that Hays does not meet claims 5, 6, and 8 because the claims recite that the insulating member is only in axial contact with a radially extending surface of the membrane spring and recite that the insulating member extends circumferentially. The examiner disagrees. The limitations referred to are only in claim 5, but not claim 8. Thus this argument does not apply to claim 8. It is the examiner's position, however, that Hays does meet these limitations. The insulating member in Hays can be considered to be the balls and the retainer ring since the claims do not require that the insulating member be of only a single one-piece element, i.e., the insulating member can include a metal portion and an additional portion. (Note, too, that the retaining ring can be a rigid member, as in the Fig. 4 embodiment of Hays.) This insulating member is only in axial contact with the membrane spring and it extends circumferentially. With respect to claim 6, applicant argues that although the balls may be in axial contact with the spring they do not contact the pressure plate. Actually the balls do contact the spring and the pressure plate in the embodiments of Figs. 4-6; but, as noted above, the insulating member can be considered to be the balls and the retainer ring.

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The rejection of claim 8 based on Jarrett('874) is withdrawn in view of the language added to claim 8. For the above reasons it is still maintained that claims 5-8 constitute an improper recapture of claimed subject matter canceled in the application for the patent and that claims 5,6, and 8 are anticipated by the Hays patent.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703) 308-2904. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor, can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



RODNEY H. BONCK
PRIMARY EXAMINER
ART UNIT 3681

rhb
May 4, 2001